REMARKS/ARGUMENTS

Claims 14-25 and 27 are pending in the application. Claims 14-19, 21, and 27 are amended. No Claims are canceled or added. The amendments to the claims as indicated herein do not add any new matter to this application.

CLAIM REJECTIONS—35 U.S.C. § 102 and 35 U.S.C. § 103

Claims 14 and 15 were rejected under 35 U.S.C. § 102(e) as being allegedly unpatentable over U.S. Patent No. 6,449,634 ("Capiel"). This rejection is respectful\ly traversed.

Claims 16 was rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Capiel* in view of U.S. Patent No. 6,434,745 ("*Conley*"). This rejection is respectfully traversed.

Claims 14, 15, 17-19, 21-25, and 27 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 6,836,792 ("Chen") in view of *Capiel*. This rejection is respectfully traversed.

Claims 16 and 20 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over *Chen* in view of *Conley*. This rejection is respectfully traversed.

Each of the pending claims recites one or more elements that are not disclosed, taught, or suggested by the cited art.

Claim 14

Claim 14 recites:

> A method for generating revenue using electronic mail, comprising the steps of:
> receiving an e-mail message addressed to at least one e-mail recipient from a first client computer through at least one computer network, wherein the e-mail message comprises an e-mail address of an e-mail user sending the e-mail message, an e-mail address of the at least one e-mail recipient, a subject, and a body;
> **appending advertisement retrieval software means to the e-mail message transmitted from the first client computer, wherein the advertisement retrieval software means comprises information about at least one of a plurality of advertisements retrievably stored in a database that**

> **are not from the e-mail user sending the e-mail message**;
> and
> transmitting the e-mail message to a second client computer
> through the at least one computer network based upon the
> e-mail address of the at least one e-mail recipient <u>for</u>
> displaying the e-mail message on the second client
> computer, wherein when the email message is first
> displayed on the second client computer the advertisement
> software retrieval means is operable at the second client
> computer to retrieve at least one of the advertisements
> retrievably stored in the database for display within the e-
> mail message on the second client computer. (emphasis
> added)

At least the above-bolded portions of Claim 1 are not anticipated by *Capiel*.

The Office Action states that the bolded limitation is anticipated by *Capiel* as HTML image

tag 316, Fig. 3, and col. 4 lines 52-60, col. 7 lines 34-46, and col. 6 lines 1-55. (Office Action, p.

2). However, a review of *Capiel* indicates that the emails that are sent in *Capiel* are part of an email

sensing system that senses the types of file formats that can be displayed by an email client (*Capiel*,

Abstract). As such, the email sensing emails that are sent in *Capiel* are in fact from a single vender

attempting to determine the type of file formats that can be displayed. The HTML image tag in

Capiel is part of an email where the entire email is an advertisement. Thus, the email message and

the HTML image tag in Capiel are from the same entity. This is different than Claim 14 that recites

"**wherein the advertisement retrieval software means comprises information about at least**

one of a *plurality of advertisements retrievably stored in a database that are not from the e-

mail user sending the e-mail message.*" Simply, image sensing and appending advertisement

retrieval software are not the same and Capiel does not anticipate at least one limitation of Claim

14.

As at least one element recited by Claim 14 is not anticipated by *Capiel,* it is respectfully

submitted that Claim 14 is patentable over the cited art and is in condition for allowance.

The Office Action also cites *Chen* in view of *Capiel* as teaching or suggesting Claim 14. However, the Office Action admits that *Chen* fails to teach or suggest "**appending advertisement retrieval software means to the e-mail message transmitted from the first client computer, wherein the advertisement retrieval software means comprises information about at least one of a plurality of advertisements retrievably stored in a database that are not from the e-mail user sending the e-mail message.**" It was explained above that *Capiel* does not teach or suggest this limitation also. Therefore, Applicants respectfully request that the Examiner withdraw the rejection of Claim 14 under 35 USC 102(e) and 103(a).

<u>Claims 18 and 21</u>

With respect to independent claims 18 and 21, *Chen* fails to teach or suggest "storing an identifier for an entity selected by an email user sending an email message" (Claim 18) and "appending a sub-message associated with an advertisement to the e-mail at a host server while the e-mail is enroute to the recipient based upon preferences of the e-mail user that composed the email". The teachings of *Chen* are focused on preferences of email recipients, *not preferences of email users that send the email*. The Office Action states in the Response to Arguments that email "user" may be both a sender and recipient. However, as used in Claims 14, 18, and 21, the email user is the one who composes or sends the email and the recipient is clearly the recited as the "recipient". Based upon the context of Claims 18 and 21, it is not logical to interpret the e-mail user as anything but the e-mail user. Thus, Claims 18 and 21 have been amended to clarify that the e-mail user is the e-mail user sending the e-mail message or the e-mail user that composed the message. *Capiel* is mentioned by the Office Action only to discuss the limitation

of appending advertisement retrieval software and not with preferences of email recipients and

does not apply. As such, not all limitations of Claims 18 and 21 are taught or suggested by *Chen*

or *Capiel*, considered alone or in combination. Thus, Claims 18 and 21 should be allowed.

Dependent Claims

Claims 15-17 are dependents of independent Claim 14. Claims 19-20 are dependents of

independent Claim 18. Claims 22-25 and 27 are dependents of independent Claim 21. These

dependant claims also include the limitations of claims upon which they depend. Each of these

dependant claims is therefore allowable for the reasons given above for the claim on which it

depends. In addition, each of the dependant claims introduces one or more additional limitations

that independently render it patentable. However, due to the fundamental differences already

identified, to expedite the positive resolution of this case a separate discussion of those

limitations is not included at this time, although the Applicants reserve the right to further point

out the differences between the cited art and the novel features recited in the dependent claims.

Thus reconsideration of the rejection on these claims is respectfully requested.

CONCLUSION

For the reasons set forth above, it is respectfully submitted that all of the pending claims

are now in condition for allowance. Therefore, the issuance of a formal Notice of Allowance is

believed next in order, and that action is most earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is

believed that such contact would further the examination of the present application.

Please charge any shortages or credit any overages to Deposit Account No. 140225.

Respectfully submitted,

NCR Corp.

Dated: ____4/1/10_____   ___/RobertSChee#58554/_____
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